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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

12 NEXTDOOR.COM, INC., a Delaware corporation,

13

Plaintiff,

14 || V

15 RAJ ABHYANKER, an individual,

16 || Defendant.

| Case No. 3:12-cv-05667-EMC-NMC

**DEFENDANT RAJ ABHYANKER'S
OPPOSITION TO PLAINTIFF
NEXTDOOR.COM, INC.'S MOTION FOR
SUMMARY JUDGMENT ON
NEXTDOOR.COM'S COUNTS II AND IV OF
ITS COMPLAINT**

Date: October 16, 2014
Time: 1:30 p.m.
Courtroom: 5 – 17th Floor
Judge: Hon. Edward M. Chen

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25		
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1	<i>Rodeo Collection, Ltd. v. W. Seventh,</i> 812 F.2d 1215 (9th Cir. 1987)	15
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I. INTRODUCTION

2 Currently pending before the Court is plaintiff Nextdoor.com’s Motion for Summary
3 Judgment on Nextdoor.com’s fourth cause of action pursuant to Federal Rule of Civil Procedure
4 56 (the “Motion”). It seeks an order finding that the use by defendant Raj Abhyanker
5 (“Abhyanker”) of the NEXTDOOR mark constitutes trademark infringement as a matter of law.
6 Docket No. 332.¹ Nextdoor.com’s opening papers do not rule out material factual issues
7 concerning both trademark validity and consequent protectability, as well as concerning the
8 likelihood of public confusion it claims was generated by the allegedly-infringing acts of
9 defendant Abhyanker. As such, this claim should proceed to trial.

10 Nextdoor.com is so determined to have the Court jump to the conclusion that infringement
11 is pre-ordained based on the procedural history of this case that it skips quickly through and fails
12 to consider the need for a valid, protectable trademark – a necessary predicate of any
13 infringement claim. Nextdoor.com has not met its burden of demonstrating that its claimed
14 NEXTDOOR trademark is valid and protectable. Significantly, there exist material disputes of
15 genuine fact as to: (a) whether the NEXTDOOR mark is merely descriptive; and (b) whether the
16 NEXTDOOR mark had achieved secondary meaning by the time of the allegedly-infringing acts.
17 Indeed, Nextdoor.com has put forward no evidence supporting its bald contention that its mark is
18 suggestive, and thus warrants protection, or that, if merely descriptive, its mark had nevertheless
19 acquired secondary meaning by the time of the allegedly-infringing acts. The Court thus need not
20 even proceed to consider the likelihood of confusion analysis set forth in *AMF, Inc. v. Sleekcraft*
21 *Boats*, 599 F.2d 341, 348-349 (9th Cir. 1979). But assuming *arguendo* that the Court finds as a
22 matter of law that the NEXTDOOR mark is distinctive or that it had acquired secondary meaning

²⁵ ¹ The Motion also seeks partial summary judgment on Count II of the Complaint. However,
²⁶ because the Court granted Nextdoor's motion to dismiss Count II following a September 17, 2014
hearing, there is no further need to take up this claim here.

1 by the time of the allegedly-infringing acts, there still exists a genuine issue of material fact
2 regarding whether Mr. Abhyanker's alleged uses of the NEXTDOOR mark created a likelihood
3 of confusion pursuant to some of the *Sleekcraft* factors which should prevent summary judgment
4 from issuing here.

5 **II. STATEMENT OF PERTINENT FACTS AND PROCEDURAL HISTORY**

6 **A. Abhyanker's Invention of and Early Efforts to Develop the Nextdoor Concept**

7 During the 2005 to 2006 timeframe, Abhyanker was surprised by the lack of web-based
8 tools available to aggregate and organize information about next-door neighbors living near each
9 other into social networks. Declaration of Raj Abhyanker ("Abhyanker Decl.") ¶ 4. So, he set
10 about developing the technological tools by which to manage large amounts of user connections,
11 to determine relevancy from large amounts of social network-connected content, to provide real-
12 time updates to users, to create printable walking maps of neighborhoods based on user
13 contributions, to filter relevant feeds across multiple networks and across group interactions, and
14 to annotate information regarding neighbors around a particular focal point. *Id.* The result was a
15 mash-up of maps, and ultimately an entry page for each user-neighbor. *Id.* From this work,
16 Abhyanker hatched the concept of Nextdoor, a neighborhood-based social network geared toward
17 bringing neighbors with like interests, or in need of a product or service offered other neighbors,
18 together for mutual benefit. *Id.*

19 Abhyanker first began using term "nextdoor" in identifying his neighborhood social
20 network inventions many years before the first adoption of the term "nextdoor" by plaintiff
21 Nextdoor.com, principally through informal use of the term in its commonly-understood sense
22 with staff and in patent applications filed in 2006. *Id.* at ¶ 5. As his ideas started to coalesce, in
23 2005 and 2006, Abhyanker's assistant and business partner Babar Rana created screenshots and
24 wireframes showing the name "Nextdoor," including two mock-up images with two home
25 addresses – Rana's and his – as focal points. A tag-line message appeared on that mock-up
26 stating "[g]et to know your neighbors." *Id.* at ¶ 6. Over the ensuing months, Abhyanker
27 developed and software code, product concepts, prototypes and other instrumentalities, including

1 use of the name “nextdoor,” in conjunction with his dream of a private social network to bring
2 neighbors closer together and to create stronger neighborhoods. *Id.* at ¶ 7. As part of his efforts,
3 Abhyanker set about transforming the Cupertino, Lorelei (Menlo Park), and other neighborhoods
4 into ideal locations to test a neighborhood-based social network, including manual efforts to
5 establish connections between residents and overcome a lack of interest. *Id.* at ¶ 8. Abhyanker
6 went door-to-door to establish these connections between residents, and engaged in extensive
7 discussions with residents to overcome any initial lack of interest among residents. *Id.*

8 In September 2006, years before Nextdoor.com came into existence or was even a thought
9 to its 2010 management team, Abhyanker hired Sandeep Sood and his firm to provide software
10 and website development services. *Id.* at ¶ 9. He and his firm agreed to conceptualize, design
11 and build components, including messaging, online identity design, information architecture, and
12 customization of social networking software. *Id.* Abhyanker created a cap table and equity
13 distribution spreadsheet for a company to be called NextDoor, Inc. with Sood in 2006. Sood was
14 to be the CEO of this venture, NextDoor, Inc. *Id.* Together with Sood and engineer Ankur
15 Verma, Abhyanker created the alpha neighborhood-based social networking site displaying the
16 name Nextdoor. The prototype Nextdoor site was developed by Sood with help from Verma. *Id.*
17 at ¶ 10.

18 Despite his repeated efforts between 2006 and 2010, Abhyanker could not use the domain
19 name Nextdoor.com because he could not purchase the domain from its third-party owner (not
20 Nextdoor.com). *Id.* at ¶ 11. Abhyanker was, however, successful in purchasing Nextyard.com
21 and Nextlawn.com in 2006, as well as more than a dozen other similarly-sounding domain names,
22 to create and bolster his presence in the neighborhood-based social networking sphere. *Id.*

23 In September 2007, Abhyanker posted a blog entitled “Creating a Consumer Domain
24 Name,” in which the nextdoor concept features as follows: “[w]hen I came up with the name for a
25 start-up that I created last year (Fatdoor, Inc.), at first I wanted to use the name NEXTDOOR.
26 Nextdoor is a nice name because it is descriptive of the geo-spatial social network I wanted to
27 create.” *Id.* at ¶ 13.

1 Also in or around September 2007, a U.S. Patent application Serial 20070218900 was
2 published by the United States Government worldwide through the Patent Gazette on which
3 Abhyanker was the sole inventor. *Id.* at ¶ 14. This application describes Abhyanker's use of the
4 "nextdoor.com" domain within a neighborhood social network. In the background of this
5 published U.S. patent application, Abhyanker refers to the term "next-door" descriptively when
6 he stated "for example, in many American communities, while a few active residents know a lot
7 of their neighbors, there are far more residents who do not even know what professions, interests,
8 and reputations are of their immediate next-door neighbors." *Id.*

9 In or around September 2007, an international patent application PCT/US2007/005612 on
10 which Abyhanker is also the sole inventor which describes his use of the "nextdoor.com" domain
11 with a neighborhood social network was published. *Id.* at ¶ 15. As was by then his custom,
12 Abhyanker referred to the term "next-door" descriptively in this case as well when he stated "for
13 example, in many American communities, while a few active residents know a lot of their
14 neighbors, there are far more residents who do not even know what professions, interests, and
15 reputations are of their immediate next-door neighbors." *Id.*

16 In or around November or December 2010, Abhyanker met with Silicon Valley investors
17 to reinvigorate Nextdoor, so as to avoid abandonment of the patents on which he was listed as
18 inventor. *Id.* at ¶ 16. For similar reasons, on December 28, 2011, Abhyanker filed a trademark
19 application for the NEXTDOOR mark in an effort to protect his rights associated with the
20 Nextdoor name dating back some six years. *Id.* at ¶ 17.

21 B. **Nextdoor.com's Adoption of the Unregistered NEXTDOOR Mark**

22 By its own admission, Nextdoor.com did not file "its application for the NEXTDOOR
23 Mark [until] February 2011." Compl. ¶ 56. *See also* Mot., at 3:10-13. To date, as Nextdoor
24 concedes, the NEXTDOOR mark has not been registered, as the issue of the registrability of the
25 NEXTDOOR mark is currently pending in "ongoing Opposition proceedings in the TTAB."
26 Compl. ¶ 57.

27 ////

1 C. Abhyanker's Alleged Use of the NEXTDOOR Mark

2 In the Motion, Nextdoor.com contends that Mr. Abhyanker "admitted that, if
3 Nextdoor.com had priority [in the NEXTDOOR mark], its priority would be no later than October
4 26, 2011," Mot., at 3:20-24, which is the date of Nextdoor.com's nationwide launch. *Id.* at 3:13-
5 20. Nextdoor.com further contends that Abhyanker has admitted that he used the NEXTDOOR
6 mark on several occasions after the October 26, 2011 launch date, in the following instances:

- 7 a. Approximately two months after Nextdoor.com's launch when Abhyanker
8 submitted a federal trademark registration application for the mark NEXTDOOR in standard
9 characters (Mot., 4:6-10);
- 10 b. At around the same time when Abhyanker registered the www.nextdoor.cm
11 domain name and began using the term "nextdoor" on other websites that he controlled (Mot., at
12 4:10-18);
- 13 c. On February 9, 2012 or later, when Abhyanker operated other websites, such as
14 www.nextlawn.com and www.nextyard.com, each of which redirected to a website on which he
15 incorporated the NEXTDOOR mark and the phrase www.nextdoor.com on various pages on the
16 website, including on the landing page, Terms of Use, About Us and other sub-pages (Mot. at
17 4:18-5:23); and
- 18 d. On some undetermined date after Nextdoor.com's launch, Abhyanker incorporated
19 the NEXTDOOR mark into other websites, such as the www.eatbid.com website. (Mot., at 5:24-
20 6:4).²

21 Abhyanker does not dispute these uses of a Nextdoor name he conceived of, only the legal

22 _____

23 ² Nextdoor.com also claims that Abhyanker continued to use the NEXTDOOR mark after the
24 Court issued partial final judgment that Nextdoor.com owned the mark, in that the judgment, *see*
25 *infra*, applied to Abhyanker's use of the NEXTDOOR mark on www.nextlawn.com,
26 www.nextyard.com, and www.eatbid.com. Mot., at 6:12-20. However, Nextdoor.com also
concedes that Abhyanker discontinued his use of these marks on these websites in response to its
requests to do so. Mot., at 6:17-20.

1 significance of having done so, as argued herein.

2 **D. The Court Enters Partial Judgment as to the First Cause of Action**

3 Following the filing of its complaint in this case and nearly two years of intensive
4 litigation, Nextdoor.com sought to resolve the first cause of action seeking declaratory relief with
5 respect to ownership and priority of use of the NEXTDOOR mark. On May 14, 2014, the parties
6 filed an Amended Stipulation for Partial Dismissal and Declaratory Judgment (“Stipulation”).
7 Declaration of Jennifer Kelly (“Kelly Decl.”), ¶ 15. *See also* Dkt. 190 (Stipulation). On May 16,
8 2014, the Court entered an Order for Partial Dismissal and Judgment (“Order”) and a Partial Final
9 Judgment Pursuant to Fed.R.Civ.P. 54(b) and 58(a) (“Judgment”). Kelly Decl. ¶¶ 15, 16. *See*
10 *also* Dkt. 192 (Order and Declaratory Judgment) *and* 193 (Judgment). The May 16, 2014 Order
11 and Judgment decreed the following:

- 12 • “All of Counterclaimant Raj Abhyanker’s claims to priority of use and ownership of the
13 NEXTDOOR mark are hereby dismissed with prejudice.” Dkt. 192 (Order) ¶ 1. *See also*
14 Dkt. 193 (Judgment) ¶ 2 (same).
- 15 • “Plaintiff Nextdoor.com, Inc. owns trademark rights in and has priority of use of the
16 NEXTDOOR mark in the field of online social networking.” Dkt. 192 (Order) ¶ 2. *See*
17 *also* Dkt. 193 ¶ 1 (same).
- 18 • “Nothing herein precludes any party from introducing evidence in support of or
19 opposition to any claim or defense not adjudicated in this Order.” Dkt. 192 (Order) ¶ 3.
- 20 • “Abhyanker, and each of his agents, servants, and employees, and those persons in active
21 concert or participation with any of them who receive actual notice of this order, shall not
22 use the NEXTDOOR mark, or any colorable imitation thereof or confusingly similar term,
23 in the field of online social networking for so long as Nextdoor.com or its successors has
24 not abandoned the NEXTDOOR mark or ceased use of the mark.” Dkt. 192 (Order) ¶ 4.
25 *See also* Dkt. 193 ¶ 3 (same).
- 26 • “This order and the Partial Judgment to be entered hereon does not adjudicate the issue of
27 whether Nextdoor.com’s use of the NEXTDOOR mark creates a likelihood of confusion
28 as to source with Abhyanker’s use of the FATDOOR mark. Nothing in this stipulation and
29 order shall affect or limit Abhyanker’s alleged right to use the mark FATDOOR in the
30 field of online social networking, as to which all parties reserve all rights.” Dkt. 192
31 (Order) ¶ 5.
- 32 • “The clerk shall enter the attached Partial Judgment pursuant to Rule 54(b), as there is no
33 just reason for delay. The time for any motion for attorney’s fees or costs to be filed

1 thereon is extended, pursuant to Rule 54(d)(2)(B), through the entry of a final judgment
2 disposing of this entire action.” *Id.* ¶ 6.

3
4 The Stipulation is clear as to its scope. It is directed to the relief sought by Nextdoor.com
5 in the first cause of action in its Complaint, which seeks “a declaratory judgment that it has
6 established trademark rights, including priority of use, of the NEXTDOOR mark in the field of
7 online social networking.” Dkt. 190 (Stipulation) ¶ 3. Nextdoor.com’s second, third and fourth
8 causes of action remained “unaffected by and survive this stipulation and order,” with the
9 exception of a waiver of recovery of damages and disgorgement of profits as to the fourth cause
10 of action. *Id.* ¶ 3. “Nothing in this Stipulation shall be construed as an admission of liability or
11 wrongdoing of any kind by any of the parties hereto.” *Id.* ¶ 4.³

12 As noted above, the second cause of action seeking declaratory relief in the way of
13 protection against future infringement claims against Nextdoor.com by Abhyanker through
14 Fatdoor, Inc. has been voluntarily dismissed by Nextdoor.com. The third cause of action, for
15 cybersquatting by Abhyanker, is not a subject of the Motion – though it is susceptible to the same
16 trademark validity challenge as is the fourth cause of action, as further described below.

17 **E. Expert Testimony Supporting Weakness of the NEXTDOOR Mark**

18 Abhyanker has retained expert witness Patrick Michael O’Leary to offer an opinion as to
19 “whether the NEXTDOOR trademark is distinctive, as such a finding is a predicate to both
20 infringement and cybersquatting enforcement.” Declaration of Patrick Michael O’Leary
21 (“O’Leary Decl.”) ¶ 4. In his supporting declaration, O’Leary demonstrates that he has the
22 training and experience to offer an expert opinion on this topic. O’Leary Decl. ¶¶ 2-3.

23
24 ³ Nextdoor.com contends that thus, it has already been established that Nextdoor.com owns valid
25 trademark rights in . . . the NEXTDOOR mark in the field of online social networking. MSJ
26 14:12-25. However, the Stipulation, the Order and the Judgment do not address whether the
unregistered NEXTDOOR mark is distinctive, valid, or protectable. Rather, their silence on these
issues indicates that Abhyanker the ability to challenge validity of the trademark as needed to
adjudicate

1 In particular, O’Leary opines that “[a] trademark is classified along a range or spectrum
2 running from strong marks to weak marks.” *Id.* ¶ 5. Consistent with the relevant case law
3 concerning the relative strength of a mark starting from weakest to strongest, he notes that a
4 trademark can be classified as (1) fanciful, (2) arbitrary, (3) suggestive, (4) descriptive, and (5)
5 generic. *Id.* ¶¶ 5-9. Upon due consideration, O’Leary readily concludes that the NEXTDOOR
6 mark is a merely descriptive, *id* at ¶¶ 4, 12, for the following reasons:

7 First, “[t]he NEXTDOOR name is so commonly used in the common parlance that it is
8 defined by the dictionary as three parts of speech, depending on usage. The public uses this term
9 as an adverb, an adjective, and a noun. Whatever its part-of-speech usage, consumers who use
10 the term “nextdoor” are immediately drawn to the notion of neighborhood, and to structures
11 situated and persons living nearby within it. This is precisely the definitional notion that
12 Nextdoor.com is tapping into when advertising and selling its online service. No imaginative or
13 creative leap is necessary to associate the trademark NEXTDOOR with the notion of bringing
14 neighbors together.” *Id.* ¶ 10.

15 Second, “the term ‘nextdoor’, in addition to being its own word used in three parts of
16 speech, is a combination of two component words – ‘next’ and ‘door.’ Like ‘nextdoor’, ‘next’
17 and ‘door’ are extremely common, to the point of entering everyday usage. Each component
18 word is itself highly descriptive, and not at all fanciful /arbitrary or even suggestive of anything
19 beyond their normal, everyday meanings.” *Id.* ¶ 11.

20 Third, in considering whether “nextdoor” could be suggestive, O’Leary explains that:

21 Suggestive trademarks often contain parts of, or play on, real words
22 – such as Liquid Paper for corrective fluid, or Enchancia for a
23 magical place enjoyed by children in games or on television. From
24 the extensions of real words, or the play on or interplay between
25 words, the consumer’s imagination is sparked into an associative
26 jump from the trademark term toward the product or service offered
27 in connection with it. It is this creativity, this imaginative jump
from trademark term to product or service offered, that stands as the
hallmark of a suggestive mark – and precisely what enables it to
gain trademark protection. By contrast, descriptive marks do not
spur the consumer’s imagination to jump to a far-off place, or to a
new commercial notion derived from the playfulness of words
comprising the trademark – they simply direct the consumer, in one

1 fell swoop, through their dictionary definitions, to the qualities or
2 characteristics of the product or service being offered.

3 As a term with a fixed meaning in our vernacular, NEXTDOOR
4 does not invite the imagination to leap, but simply takes the mind
5 on a linear course to a characteristic or feature of what it means to
6 be “nextdoor” – that is, interacting with one’s neighbors, crossing
7 between one’s homes. This is precisely the service offered by
8 Nextdoor.com.
9

10 *Id.* ¶¶ 13-14. For these reasons, O’Leary concludes that “the NEXTDOOR trademark is
11 descriptive, not distinctive, and thus cannot form the basis of either an infringement claim or a
12 cybersquatting claim.” *Id.* ¶ 14. O’Leary also reviewed the possibility that, though descriptive,
13 the NEXTDOOR mark might have acquired secondary meaning such that it could properly be the
14 basis of an enforcement action. *Id.* at ¶15. But, given the few months Nextdoor.com was in
15 existence at the time of the infringing acts complained of, he concludes that “it was not yet
16 possible for the Nextdoor trademark to have acquired secondary meaning with the public at that
17 early stage of Nextdoor.com’s development.” *Id.*

18 The Motion is set for hearing on October 16, 2014. Trial is set for December 8, 2014.

19 **III. ARGUMENT**

20 **A. Legal Standard**

21 Rule 56(c) of the Federal Rule of Civil Procedure provides that summary judgment “shall
22 be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on
23 file, together with the affidavits, if any, show that there is no genuine issue as to any material fact
24 and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. Pro. 56(c).
25 Material facts are those that may affect the outcome of the case. *See Anderson v. Liberty Lobby,*
26 *Inc.* 477 U.S. 242, 248 (1986). A dispute as to a material fact is “genuine” if there is sufficient
27 evidence for a reasonable jury to return a verdict for the nonmoving party. *See id.* The Court
28 may not weigh the evidence. *Id.* at 255. Rather, the nonmoving party’s evidence must be
29 believed, and “all justifiable inferences must be drawn in [the nonmovant’s] favor.” *See United*
30 *Steelworkers of Am. v. Phelps Dodge Corp.*, 865 F.2d 1539, 1542 (9th Cir. 1989) (en banc), citing
31 *Liberty Lobby*, 477 U.S. at 255.

1 The moving party bears the initial responsibility of informing the district court of the basis
2 for its motion and identifying those portions of the pleadings, depositions, interrogatory answers,
3 admissions and affidavits, if any, that it believes demonstrate the absence of a genuine issue of
4 material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Where the moving party
5 “bears the burden of proof at trial, he must come forward with evidence which would entitle him
6 to a directed verdict if the evidence went uncontested at trial.” *See Houghton v. South*, 965
7 F.2d 1532, 1536 (9th Cir. 1992) (citations omitted); *see also Fontenot v. Upjohn*, 780 F.2d 1190,
8 1194 (5th Cir. 1986) (when plaintiff moves for summary judgment on an issue upon which he
9 bears the burden of proof, “he must establish beyond peradventure all of the essential elements of
10 the claim . . . to warrant judgment in his favor”).

11 B. **Nextdoor.com Has Failed to Establish Infringement of the NEXTDOOR**
12 **Trademark as a Matter of Law**

13 “[S]ummary judgment is generally disfavored in the trademark arena.” *KP Permanent*
14 *Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 602 (9th Cir. 2005), quoting
15 *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1140 (9th Cir. 2002). To prevail on a claim of
16 trademark infringement under the Lanham Act, a party must prove: (1) that it has a protectable
17 ownership interest in the mark; and (2) that the defendant’s use of the mark is likely to cause
18 consumer confusion. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137,
19 1144 (9th Cir. 2011). It is axiomatic that “**a plaintiff trademark owner must establish a valid,**
20 **protectable interest in order to proceed to the second prong of the trademark infringement**
21 **analysis**—the likelihood of confusion resulting from the defendant’s alleged infringing use.”
22 *Applied Info. Scis. Corp. v. eBay, Inc.*, 511 F.3d 966, 972 (9th Cir. 2007) (emphasis added).

23 Here, Nextdoor.com has failed to establish as a matter of law that (1) the NEXTDOOR
24 mark is valid and protectable, or that (2) Mr. Abhyanker’s use of the NEXTDOOR mark is likely
25 to cause confusion. At a minimum, there exist genuine issues of material fact as to both elements
26 which preclude summary judgment.

1 **1. Nextdoor.com Has Failed to Establish that the NEXTDOOR Mark Is**
2 **Presumptively Valid Because the Mark Is Not Registered**

3 To claim trademark infringement, a plaintiff must have a valid, protectable trademark.
4 *Brookfield Commc’ns, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1046 (9th Cir. 1999). The
5 issue of trademark validity is considered “an intensely factual issue.” *KP Permanent Make-Up,*
6 *Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 605 (9th Cir. 2005). The plaintiff bears the
7 ultimate burden of proof in a trademark-infringement action that the trademark is valid and
8 protectable. *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 927-
9 28 (9th Cir. 2005). The NEXTDOOR mark is and remains unregistered. There is no dispute as to
10 this fact. Because Nextdoor.com has not and cannot establish that the NEXTDOOR mark has
11 been registered, it is not entitled to a presumption that the mark is valid and protectable.
12 *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1204 n.3 (9th Cir. 2000). When a mark “is
13 not registered with the United States Patent and Trademark Office, the burden is on the claimant
14 to establish its entitlement to protection.” *Platinum Home Mortg. Corp. v. Platinum Fin. Group*,
15 149 F.3d 722 (7th Cir. 1998). As such, at the outset, Nextdoor.com does not obtain the benefit of
16 a presumption of validity, and carries the full, unaided burden of establishing that it has a
17 protectable trademark on which to base its infringement claim.

18 **2. The Uncontroverted Evidence Supports That the NEXTDOOR Mark**
19 **Is a Descriptive Mark, and in any Event Cannot be Found to Be a**
20 **Distinctive Mark as a Matter of Law**

21 To be valid and protectable, a mark must be distinctive. Distinctiveness measures the
22 primary significance of the mark to the purchasing public. *Quiksilver, Inc. v. Kymsta Corp.*, 466
23 F.3d 749, 760 (9th Cir. 2006) (quotations omitted). In determining distinctiveness, courts are
24 required to consider standards of meaning not of their own, but prevalent among prospective
25 purchasers of the article. *Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8, 11 (9th Cir. 1970);
26 see also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:70 (4th
27 ed. 2010) (“*McCarthy on Trademarks*”). The fact-finder is not the designated representative of
the purchasing public, and the fact-finder’s own perception of the mark is not the object of the
inquiry. Rather, the fact-finder’s function is to determine, based on the evidence before it, what

1 the perception of the purchasing public is. *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*,
2 192 F.3d 337, 344 (2d Cir. 1999). As demonstrated below, the mark at issue is a descriptive
3 mark; at the very least, there is a genuine issue of material fact as to whether the mark is
4 distinctive or descriptive.

5 Marks are classified in categories of increasing strength. A mark may be (1) generic; (2)
6 descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *Two Pesos, Inc. v. Taco Cabana, Inc.*,
7 505 U.S. 763, 768 (1992). *See also* O’Leary Decl. ¶¶ 5-9. The latter three categories of marks,
8 because of their intrinsic ability to identify a particular source of a product or service, are deemed
9 inherently distinctive and are therefore entitled to automatic and immediate trademark protection.
10 *Two Pesos*, 505 U.S. at 769. *See* O’Leary Decl. ¶¶ 5-7. At the other end of the spectrum are
11 generic marks, which are never protected. *Two Pesos*, 505 U.S. at 769. *See* O’Leary Decl. ¶ 9.
12 That leaves descriptive marks, which are not considered inherently distinctive because they define
13 a particular characteristic of a product or service in a way that does not require any exercise of the
14 imagination. *SurfvivorMedia, Inc. v. Survivor Prods.*, 406 F.3d 625, 631-32 (9th Cir. 2005). *See*
15 O’Leary Decl. ¶ 8. A descriptive mark can become protectable only after it has acquired
16 distinctiveness through extensive use in commerce. *Sand Hill Advisors, LLC v. Sand Hill*
17 *Advisors, LLC*, 680 F. Supp. 2d 1107, 1113 (N.D. Cal. 2010), citing *Lahoti v. VeriCheck, Inc.*, 586
18 F.3d 1190, 1196-97 (9th Cir. 2009).

19 Courts have long recognized the intensively-factual nature of making a determination as
20 to the strength of a given mark, calling the process “a tricky business at best.” *Lahoti v.*
21 *VeriCheck, Inc.*, 586 F.3d 1190, 1197-98 (9th Cir. 2009), citing *Bannf, Ltd. v. Federated Dep’t*
22 *Stores, Inc.* 841 F.2d 486, 489 (2d Cir. 1988); *see also Pizzeria Uno Corp. v. Temple*, 747 F.2d
23 1522, 1528 (4th Cir. 1984) (“The line between descriptive and suggestive marks is scarcely
24 ‘pikestaff plain’ and the distinction to be given the two terms is frequently made on an intuitive
25 basis rather than as a result of a logical analysis susceptible of articulation”). After taking note of
26 the general rule of law as to what constitutes a suggestive mark, “*a trier of fact* is still left with a
27 hard task of judgment” as to where a particular mark falls in “the continuum between marks” that

1 are suggestive and those that are only descriptive. *Lahoti*, 586 F.3d at 1198 (emphasis added).
2 Recognizing the intensity of this factual exercise, the issue of distinctiveness of a mark is nearly
3 always a matter found to be “unsuitable for a summary judgment determination.” *Zobmondo*
4 *Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1120 (9th Cir. 2010).

5 **a. The NEXTDOOR Mark Is Not a Fanciful or Arbitrary Mark**

6 A strong mark, and thus a mark that is instantly afforded trademark protection, is a mark
7 that is either arbitrary or fanciful. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir.
8 1979). Here, Nextdoor.com has not established, and cannot establish, that its mark is either
9 arbitrary or fanciful.

10 A fanciful mark is a mark that consists of a made-up, imaginative words; one court has
11 described such marks as consisting of a “word invented solely for their use as trademarks.”
12 *Abercrombie & Fitch Co.*, 537 F.2d at 11. The mark NEXTDOOR is not a made-up word of the
13 likes of Exxon, and is therefore not protectable as a fanciful mark. *See O'Leary Decl.* ¶ 11
14 (“[T]he term ‘nextdoor’, in addition to being its own word used in three parts of speech, is a
15 combination of two component words – ‘next’ and ‘door.’ Like ‘nextdoor’, ‘next’ and ‘door’ are
16 extremely common, to the point of entering everyday usage. Each component word is itself
17 highly descriptive, and not at all fanciful / arbitrary or even suggestive of anything beyond their
18 normal, everyday meanings.”).

19 An arbitrary mark is a real term that in its common meaning “has no relevance to any
20 feature or characteristic of the product.” *Kendall-Jackson Winery, Ltd. v. J. Gallo Winery*, 150
21 F.3d 1042, 1046 (9th Cir. 1998). *See O'Leary Decl.* ¶ 6. Perhaps the best-known example of an
22 arbitrary mark is Apple, the name and trademark of a computer company which through its
23 products and services does not seize on the common meaning of an apple. The NEXTDOOR
24 mark is not arbitrary. There is a clear and logical connection between the services that
25 Nextdoor.com provides, a social network for connecting neighbors who live close to one another,
26 or “next door” to one other, and the term NEXTDOOR, a term that is routinely used to refer to a
27 neighbor who lives in the next house or unit. *See O'Leary Decl.* ¶ 10 (“Whatever its part-of-

1 speech usage, consumers who use the term “nextdoor” are immediately drawn to the notion of
2 neighborhood, and to structures situated and persons living nearby within it.”).

3 **b. The NEXTDOOR Mark is a Descriptive Mark**

4 Nextdoor.com’s only manner of establishing a protectable trademark right in the
5 NEXTDOOR mark lies in establishing that it is a suggestive mark. In its opening papers,
6 Nextdoor.com makes only the faintest of attempts to establish any manner of mark strength, and
7 therefore falls short of satisfying its burden of establishing that the mark is protectable as a matter
8 of law.

9 The primary criterion for distinguishing between a suggestive and a descriptive mark is
10 “the imaginativeness involved in the suggestion, that is, how immediate and direct is the thought
11 process from the mark to the particular product.” *Self-Realization Fellowship Church v. Ananda*
12 *Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995). In order for a mark to be a
13 suggestive mark, there must be a quantifiable amount of “imagination” or a “mental leap” to
14 reach “a conclusion as to the nature of the product being referenced.” *Filipino Yellow Pages, Inc.*
15 *v. Asian Journal Pub’ns, Inc.*, 198 F.3d 1143, 1147 n.3 (9th Cir. 1999). The mental leap that is
16 required is a significant one.

17 For example, in *Jockey Club, Inc. v. Jockey Club of Las Vegas, Inc.*, 595 F.2d 1167, 1168
18 (9th Cir. 1979), the mark JOCKEY CLUB, used in the context of a condominium complex and a
19 club, did not rise past its descriptive quality to the level of a distinctive mark because the “known
20 connotations of wealth and high social status” associated with the words “Jockey Club” meant
21 that in the mind of consumers, the words did not denote “a single thing coming from a single
22 source.” Similarly, the mark OATNUT, in the context of a bread product, was held to be a
23 merely descriptive mark. *In re Entenmann’s Inc.*, 928 F.2d 411 (Fed. Cir. 1991). The mark
24 ECODIESEL, in the context of fuel, was also held to be a merely descriptive mark. *Unitek*
25 *Solvent Servs. v. Chrysler Group LLC*, 2013 U.S. Dist. LEXIS 141096 (D. Hawaii 2013), *aff’d*
26 2014 U.S. App. LEXIS 11569 (9th Cir. 2014).

27 A mark is descriptive when it “describes the product to which it refers or its purpose.” See

1 *Self-Realization*, 59 F.3d at 910 (emphasis added) (citations omitted). Descriptive marks
2 “describe[]a person, a place or an attribute of a product.” *Japan Telecom, Inc. v. Japan Telecom*
3 *Am., Inc.*, 287 F.3d 866, 872 (9th Cir. 2002). Because descriptive marks “tend to consist of
4 common words that might be the only way to describe a category of goods,” courts “do not grant
5 exclusive property rights in them.” *Id.* The determination of descriptiveness must be made “by
6 reference to the goods or services that it identifies.” *Rodeo Collection, Ltd. v. W. Seventh*, 812
7 F.2d 1215, 1218 (9th Cir. 1987); *see also McCarthy on Trademarks*, at 11:64 (“[T]he mark
8 BRILLIANT may be ‘descriptive’ on diamonds, ‘suggestive’ on furniture polish, and ‘arbitrary’ on
9 canned applesauce.”). Moreover, a mark does not need to “recite each feature of the relevant
10 goods or services in detail” in order to be a descriptive mark. *Lahoti*, 586 F.3d at 1201.

11 Here, after carefully considering the issue of what is the proper categorization of the
12 NEXTDOOR mark, O’Leary readily concluded that the NEXTDOOR mark is merely descriptive.
13 O’Leary Decl. ¶¶ 4-14. O’Leary also found that a close analysis of the NEXTDOOR mark makes
14 the descriptive nature of the mark clear, as the mark “is a combination of two component words –
15 ‘next’ and ‘door’,” both of which “are extremely common to the point of entering everyday
16 usage.” *Id.* at ¶¶ 11-12. While not determinative, such “dictionary definitions are relevant and
17 often persuasive in determining how a term is understood by the consuming public”
18 *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1015 n.11 (9th Cir.
19 1979); *see also Fortune Dynamic, Inc. v. Victoria Secret Stores Brand Mgmt.*, 618 F.3d 1025,
20 1033 (9th Cir. 2010) (“A suitable place for attempting to draw the line between a suggestive and a
21 descriptive mark is the dictionary.”). *See also* O’Leary Decl. ¶ 13 (“descriptive marks do not
22 spur the consumer’s imagination to jump to a far-off place, or to a new commercial notion
23 derived from the playfulness of words comprising the trademark – they simply direct the
24 consumer, in one fell swoop, through their dictionary definitions to the qualities or characteristics
25 of the product or service being offered”). This reasoning led O’Leary to conclude that “the
26 NEXTDOOR mark is no stronger than descriptive.” *See id.* ¶ 12.

27 Although Nextdoor.com contends that the NEXTDOOR mark is “at least suggestive,” it

1 offers absolutely no evidence to establish this mistaken assertion. *See* MSJ, at 20:15-21. The
2 most Nextdoor.com can muster is that the NEXTDOOR mark must be suggestive because it
3 “requires a ‘mental leap’ from the word ‘nextdoor’ to the service that Nextdoor.com provides, an
4 online social network for neighbors.” *Id.* However, the determination of whether a mark is
5 suggestive or descriptive requires the finder of fact to consider probable consumer reaction in the
6 specific context of how plaintiff’s service is offered in the industry. *Lahoti*, 586 F.3d at 1198.
7 Nextdoor.com has offered no such evidence on this factual inquiry. Nor did it engage an expert
8 and offer evidence in that way on this issue. Instead, the only evidence concerning strength or
9 weakness of the NEXTDOOR mark is from Mr. O’Leary: “the term ‘nextdoor’, in addition to
10 being its own word used in three parts of speech, is a combination of two component words –
11 ‘next’ and ‘door.’ Like ‘nextdoor’, ‘next’ and ‘door’ are extremely common, to the point of
12 entering everyday usage. Each component word is itself highly descriptive, and not at all fanciful
13 / arbitrary or even suggestive of anything beyond their normal, everyday meanings.” O’Leary
14 Decl. ¶ 11.

15 Accordingly, the record clearly supports that the NEXTDOOR mark is no more than
16 descriptive. At a minimum, based on the one-sided evidence presented, there exists a genuine
17 dispute of material fact as to whether the NEXTDOOR mark is descriptive or distinctive - a
18 dispute sufficient to defeat summary judgment here.

19 **3. Nextdoor.com Has Failed to Offer Any Evidence that the NEXTDOOR
20 Mark Had Acquired Secondary Meaning by the Time of the Allegedly-
Infringing Conduct**

21 To have a protectable descriptive mark, Nextdoor.com has to demonstrate that the
22 NEXTDOOR mark had obtained secondary meaning by the time that the allegedly infringing acts
23 occurred. Nextdoor.com has failed to establish that the NEXTDOOR mark has acquired
24 secondary meaning at any time, much less at the time of the alleged infringement.

25 Descriptive marks may acquire distinctiveness through use in commerce. *Sand Hill*
26 *Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F. Supp. 2d 1107, 1113 (N.D. Cal. 2010) (citing
27 *Lahoti* , 586 F.3d at 1196). This acquired distinctiveness is generally called “secondary

1 meaning.” *Two Pesos*, 505 U.S. at 769. Whether a mark has acquired secondary meaning almost
2 always presents a detailed question of fact. *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352,
3 1355 (9th Cir. 1985). A plaintiff generally cannot establish that secondary meaning was acquired
4 as a matter of law through a summary judgment motion. *Yellow Cab Co.*, 419 F.3d at 930
5 (finding summary judgment inappropriate because of the existence of a genuine issue of material
6 fact in relation to the whether secondary meaning had been established). For its part,
7 Nextdoor.com has offered no evidence whatsoever that the NEXTDOOR mark has acquired
8 secondary meaning.

9 In determining whether a mark has obtained secondary meaning, courts consider: (1)
10 whether actual purchasers of the product bearing the mark associate the mark with the producer;
11 (2) the degree and manner of advertising under the mark; (3) the length and manner of use of the
12 mark; and (4) whether use of the mark has been exclusive. *Comm. for Idaho's High Desert v.*
13 *Yost*, 92 F.3d 814, 822 (9th Cir. 1996). Critically, a plaintiff alleging trademark infringement
14 must establish that its mark had acquired secondary meaning prior to the occurrence of the
15 infringement at issue. *CG Roxane LLC v. Fihi Water Co. LLC*, 569 F. Supp. 2d 1019, 1032 (N.D.
16 Cal. 2008) (“[t]he user must [] show that secondary meaning existed prior to the date on which
17 the defendant commenced using the same or similar mark”) (internal quotations omitted).

18 Nextdoor.com neither argues that the NEXTDOOR mark has acquired secondary meaning
19 nor offers evidence with respect to any of these factors, and thus concedes the issue.⁷ Indeed,

20

21 ⁷ Nextdoor.com has failed to establish that the Nextdoor mark is valid and protectable.
22 Nevertheless, Nextdoor.com argues that Abhyanker should not be able to argue that the
23 NEXTDOOR mark is descriptive. See MSJ, n.9 (“Abhyanker is hard pressed to deny that the
24 NEXTDOOR mark is not at least suggestive since he has already acknowledged Nextdoor.com’s
25 rights in the NEXTDOOR mark”). Under the collateral estoppel doctrine, judgment in a prior suit
26 between parties precludes re-litigation by the same parties of issues actually litigated and
27 necessary to the outcome of the first action. *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352,
1357 (9th Cir. 1984). Collateral estoppel is inappropriate here because the partial judgment did
not adjudicate whether the NEXTDOOR mark is valid and protectable. See Section III(A), *supra*.
Count I of the Complaint, which was resolved by the partial judgment, did not even address or
seek a ruling on the validity and protectability of the NEXTDOOR mark. See generally, Compl.
(footnote continued on next page)

1 Nextdoor.com has not and cannot establish that the mark acquired secondary meaning, let alone
2 that the mark had accrued secondary meaning at the time of the allegedly infringing acts, as
3 required for a finding of liability. The NEXTDOOR mark simply had not achieved the required
4 level of public recognition by the time of the allegedly-infringing acts in 2011 -- just a few short
5 months after Nextdoor.com's launch -- to have secondary meaning. O'Leary Decl. ¶ 15.

6 Nextdoor.com has yet to apply the secondary meaning test. It has not offered any
7 evidence that actual purchasers of their service bearing the NEXTDOOR mark associate the mark
8 with Nextdoor.com. By Nextdoor.com's own admission, the mark has only been used in the
9 marketplace since late 2011. MSJ 4:6-8. This falls short of the five-year requirement for a
10 presumption of recognition to have developed. 15 U.S.C. § 1052(f); Trademark Manual of
11 Examining Procedure § 1212.5 (“proof of substantially exclusive and continuous use of a
12 designation as a mark by the applicant in commerce for the five years before the date on which
13 the claim of distinctiveness is made may be accepted as prima facie evidence that the mark has
14 acquired distinctiveness as used with the applicant’s goods or services in commerce”) (internal
15 citations omitted). Similarly, Nextdoor.com has put forth no evidence to establish that the mark
16 has been advertised. Finally, Nextdoor.com’s use of the term “nextdoor” has not been exclusive.
17 Indeed, evidence that third parties have made use of a mark before or during the time in which a
18 purported mark holder has made use of the mark indicates that the mark has not obtained
19 secondary meaning. *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794 (9th Cir.
20 1970); *Universal Frozen Foods Co. v. Lamb-Weston, Inc.*, 697 F. Supp. 389, 393 (9th Cir. 1987)

21 _____
22 (footnote continued from previous page)

23 ¶¶ 60-61. Rather, its focus was on relative priority between Nextdoor.com and Abhyanker
24 relating to the mark, to forestall a later infringement by Abhyanker. Compl. ¶ 59. Nextdoor’s
25 unduly expansive interpretation of the phrase “trademark rights” in the partial judgment presumes
26 those rights as against all comers even though no Court or administrative body had so found.
Nextdoor’s mistaken belief is inconsistent with the Order. Dkt. 192 (Order) ¶ 5 (parties agree that
“[n]othing herein precludes any party from introducing evidence in support of or opposition to
any claim or defense not adjudicated in this Order.”).

1 (exclusivity as a source not established when a product had been sold for many years under the
2 mark in question by others). The facts of this case make clear that use of the NEXTDOOR mark
3 originated not with Nextdoor.com but with a separate domain owner as well as with Abhyanker
4 years before its launch in 2011, and that its use by Nextdoor.com has not been exclusive
5 throughout the history of the mark. Abhyanker Decl. ¶¶ 11.

6 Accordingly, the NEXTDOOR mark had not acquired secondary meaning by the time of
7 the alleged infringement. At minimum, there is a genuine dispute of material fact as to whether
8 the mark had by then acquired secondary meaning which is sufficient to preclude summary
9 judgment.

10 **4. Assuming the Court Reaches the Likelihood of Confusion Element,
11 There Is a Genuine Issue of Material Fact as to Whether Abhyanker's
12 Use of the NEXTDOOR Mark Was Likely to Cause Confusion**

13 As noted above, the Court need not reach the likelihood of confusion analysis because
14 Nextdoor.com has not initially established that the NEXTDOOR mark is valid and protectable.
15 *See Applied Info. Scis. Corp.*, 511 F.3d at 972. Assuming *arguendo* that the mark is found to be
16 valid as a matter of law, there exist genuine issues of material fact precluding a finding of
likelihood of confusion as a matter of law.

17 Courts in this Circuit apply the well-established test set forth in *AMF, Inc. v. Sleekcraft
18 Boats*, 599 F.2d 341, 348-349 (9th Cir. 1979) (the “*Sleekcraft factors*”), for determining
19 trademark infringement under the Lanham Act. The *Sleekcraft* factors are (1) strength of the
20 mark, (2) type of goods and the degree of care likely to be exercised by the purchaser, (3)
21 likelihood of expansion of the product lines, (4) evidence of actual confusion, (5) proximity of the
22 goods, (6) similarity of the marks, (7) marketing channels used, and (8) defendant’s intent in
23 selecting the mark. *Id.* at 348-49. The existence of genuine issues of material fact as to the
24 application of at least some of the *Sleekcraft* factors should preclude summary judgment.

25 (1) The Strength of the Mark: The strength of a mark “can be measured in terms of its
26 location along a continuum stretching from arbitrary, inherently strong marks, to suggestive
27 marks, to descriptive marks, to generic, inherently weak marks.” *Surgicenters of Am., Inc. v.*

1 *Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1014-15 (9th Cir. 1979). Abhyanker has
2 established in the absence of competing evidence that the mark is merely descriptive, which is
3 indicative of a weak mark. Moreover, because the mark is unregistered, Nextdoor.com does not
4 obtain the benefit of any presumption associated with a distinctive mark. Nextdoor.com timidly
5 disagrees, contending that “the NEXTDOOR mark is at least suggestive,” and thus protectable as
6 a distinctive mark. MSJ, at 20:14-18. But, as discussed above, Nextdoor.com has offered no
7 evidence whatsoever to substantiate this contention. Accordingly, for present purposes, this
8 factor weighs heavily in Abhyanker’s favor.

9 (2) Type of Goods and the Degree of Care Likely to be Exercised by the Purchaser: In
10 assessing the likelihood of confusion to the public, the standard used by courts is the typical buyer
11 exercising ordinary caution. *AMF*, 599 F.2d at 353. Nextdoor.com has offered no evidence
12 regarding the level of sophistication or caution of the typical consumer patronizing its service.
13 Instead, Nextdoor.com argues that this factor must weigh in favor of Nextdoor.com because (a)
14 consumers are “expected to be more discerning when purchasing an expensive item and less
15 discerning (and more easily confused) when dealing with inexpensive products,” (b) “web surfers
16 are more likely to be confused as to the ownership of a web site than traditional patrons of a
17 brick-and-mortar store,” and (c) both parties operate free websites. MSJ, 19:18-19:1. But
18 Nextdoor.com’s cursory analysis ignores that its own service requires a consumer to divulge
19 personal identifying information that consumers are not likely to easily disseminate, especially
20 online through a website being viewed for the first time.

21 Indeed, as a prerequisite to accessing its website, Nextdoor.com requires a consumer to (a)
22 obtain a reference confirming a user’s address from a neighbor who’s a user the service or (b)
23 providing his or her name and street address and then providing Nextdoor.com with additional
24 authenticating information that it requests, such as a credit card number, the last four digits of the
25 user’s social security number, a unique code that Nextdoor.com mails to the user, or the user’s
26 home or mobile phone number. Abhyanker Decl. ¶ 18. A consumer will likely exercise caution
27 before divulging this type of highly-sensitive information, contrary to what Nextdoor.com

1 contends. For this reason, Nextdoor.com’s conclusion that this factor weighs towards a
2 likelihood of confusion is not so easily supported.

3 Even if other factors support Nextdoor.com’s contention of a likelihood of confusion, the
4 existence of multiple issues of material fact concerning the *Sleekcraft* factors addressed above
5 renders summary judgment inappropriate here. *See Interstellar Starship Servs. v. Epix, Inc.*, 184
6 F.3d 1107, 1110 (9th Cir. 1999) (when there is evidence supporting the non-moving party against
7 finding a likelihood of confusion, “a court should not weigh evidence on a summary judgment
8 motion”) (internal citation omitted). Accordingly, as there exists genuine disputes of material fact
9 as to whether Abhyanker’s allegedly-infringing use of the NEXTDOOR mark is likely to cause
10 confusion under the *Sleekcraft* Factors, the Motion should be denied for this reason as well.

11 **IV. CONCLUSION**

12 Summary judgment is generally not granted in the trademark infringement arena – and
13 from this brief it is easy to see why. Nextdoor.com has not established trademark validity – and
14 thus protectability – as a matter of law. Trademark validity turns on holding a distinctive mark.
15 All evidence in the record on this issue decidedly favors that the NEXTDOOR mark is no
16 stronger than descriptive. This trademark is thus not protectable – that is, it is not capable of
17 supporting an infringement claim – unless it had acquired secondary meaning by the time of the
18 allegedly-infringing acts. Again, Nextdoor.com has presented no evidence that its mark had
19 acquired secondary meaning by the time of the allegedly-infringing acts, and the evidence
20 surrounding the short timeframe between Nextdoor.com’s launch in 2011 and the allegedly
21 infringing acts months later demonstrate that secondary meaning could not have been acquired so
22 quickly. At a minimum, there are genuine issues of material fact as to trademark validity and
23 protectability, as well as there is a likelihood of confusion, which prevent summary judgment
24 from being granted at this time.

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1 Accordingly, Nextdoor's motion for partial summary judgment on the fourth cause of
2 action for trademark infringement should be denied.

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4 Dated: September 26, 2014

LEGALFORCE RAJ ABHYANKER, P.C.

5 /s/ David Levine

6 DAVID LAVINE

7 Attorney for Defendant RAJ ABHYANKER

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